REMARKS

This application was originally filed on 28 December 2001 with thirty-two claims, two of which were written in independent form. Claims 21 and 22 were canceled, and Claims 1, 17, and 18 amended on 27 October 2003. Claims 1-17 were amended on 21 January 2005. Claims 1, 5, and 6 were amended on 19 December 2005. Claims 1 and 17 were amended on 8 November 2006. Claims 33 and 34 have been added by this amendment. No claims have been allowed.

Claims 1 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,552,840 to Ishii *et al.* ("Ishii") in view of U.S. Patent No. 5,612,753 to Poradish *et al.* ("Poradish") and U.S. Patent No. 5,863,125 to Doany ("Doany"). The applicant respectfully disagrees and submits the Examiner has failed to present a prima facie case of obviousness.

The Examiner has the duty to present a prima facie obviousness rejection. A prima facie obviousness rejection requires more than merely finding each element of the claims in the prior art. "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner has not pointed to any teaching in the prior art suggesting the combination proposed by the Examiner. Instead, the Examiner merely states, "It would have been obvious to one of ordinary skill in the art at the time of the invention to add the total internal reflection prism assembly of Poradish et al. into the image display system of Ishii et al. at any position including the claimed first face of said polarizing beam splitter to add flexibility to the projector system by being able to change the shape/configurations of the system for sizing or fitting into a specific space. Further, it is very well known that spatial light modulator can provide different polarization states as evidenced by the display devices of Doany (see at least column 8, lines 25-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to manipulate the polarization states of the above system as taught by Doany to provide further flexiblity for positioning of the elements to be able to change the shape/configurations of the system for sizing or fitting into a specific space."

The applicant respectfully submits that the Examiner's statement represents neither a suggestion of the claimed combination in the prior art, nor a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references as required by *Clapp*. Instead, the Examiner's statement merely recites advantages such as changing the shape or configuration of the system that presumably would result from the applicant's combination. Following this logic, any novel combination that provides any advantages would therefore be obvious since the combination provides a recognized or unrecognized advantage. The advantages suggested by the Examiner do not appear to be suggested in the prior art, nor does the prior art suggest the modifications to the prior art that lead to the recited claim.

Furthermore, the Examiner's suggested combination appears to be non functional. It is unclear from the Examiner's statement how the total internal reflection prism of Poradish would be made to function in the system of Ishii since the various illumination and projection beams of Ishii appear to be parallel to each other. The Examiner has not explained how the total internal reflection prism assembly would separate to parallel beams.

Additionally, with respect to Claim 1, it does not appear to be possible to implement the Examiner's suggested combination. Claim 1 recites "a polarizing beam splitter on said illumination path for receiving said filtered beam of light at a first face" and "a total internal reflection prism assembly proximate said first face and on said illumination path and a projection path to separate the illumination and projection paths." Ishii's illumination path and projection path do not appear to traverse a "first face." Placing the total internal reflection prism of Poradish at Ishii's first face therefore would not separate the illumination and projection paths" as recited by Claim 1.

Thus, the Examiner has failed to show an express or implied suggestion in the art to make the combination or modification suggested by the Examiner, and does not provide a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references as required by Ex Parte Clapp. Instead, the Examiner merely appears to have used the applicants own claim as a shopping list to combine elements from the prior art. Therefore, the Examiner has not met the burden of presenting a prima facie case of obviousness and the rejection under 35 U.S.C. § 103(a) is defective and

should be withdrawn.

Claims 2, 3, 5, 6, 11, 12, 16, 18, 19, 28, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and Doany. Claims 4 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and further in view of U.S. Patent No. 6,285,415 to Brennesholtz. Claims 7 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and Doany, and further in view of U.S. Patent No. 5,121,983 to Lee. Claims 8-10 and 24-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and Doany, and further in view of U.S. Patent Publication No. 2003/0020809 to Gibbon *et al.* Claims 13 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishii in view of Poradish and Doany, and further in view of U.S. Patent No. 6,097,456 to Wang.

Claims 2-16 depend from Claim 1 and should be deemed allowable for that reason and on their own merits. Claims 18-20 and 23-32 depend from Claim 17 and should be deemed allowable for that reason and on their own merits. For the reasons cited above with respect to Claims 1 and 17, the prior art does not show, teach, or suggest the combination of limitations recited by Claims 1 and 17, much less the limitations of Claims 1 and 17 in combination with the additional limitations of the dependent claims.

Additionally, with respect to the combination of Brennesholtz and Ishii and Poradish, the Examiner has failed to either show that the references expressly or impliedly suggest the claimed combination, or present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references as required by Clapp. Brennesholtz teaches dividing a white light source into three color components, and shaping the subbands small enough that two or three are present on the panel at the same time. It is far from clear how this advantage is provided by a spiral color wheel as suggested by the Examiner.

Newly added Claims 33 and 34 are similar to Claims 1 and 17 and further include some of the limitations of Claims 14, 15, 31, and 32, which were objected to.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the pending claims are in

condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,

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